

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK J. KRAFFERT

Appeal No. 2006-1778
Application 09/776,364
Technology Center 2800

Decided: February 6, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and JEAN R. HOMERE¹, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ For purposes of rendering this decision, Administrative Patent Judge Homere has been substituted for Administrative Patent Judge Krass, who retired subsequent to the original opinion. *See In re Bose*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

This is a decision on request for rehearing.

In a paper received October 2, 2006, Appellant requests rehearing of our Decision mailed on July 27, 2006 in this appeal affirming the Examiner's rejection of all claims on appeal under 35 U.S.C. § 103.² Since Appellant's request bears a certificate of mailing of September 27, 2006, it is considered to have been timely filed.

At the outset, we note that Appellant presents no arguments in the Request for Rehearing relative to our affirmance of the Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103, the so-called first stated rejection as we labeled it in our prior Decision, over Slutz in view of Fujimori. Appellant presents arguments only to what we have characterized as the fourth and fifth stated rejections relying initially upon Gartner in view of Fitting in the fourth stated rejection and, further in view of Walls as to the fifth stated rejection. We have affirmed entirely the rejection set forth by the Examiner as to these stated rejections, which encompass all claims on appeal, claims 1 through 14, 17 through 21, and 23 through 32.

At the top of page 7 of our prior Decision, we agreed with the Examiner's reasons of for the obviousness of these claims as set forth in the Answer and Supplemental Answer regarding the particular teachings, showings and reasonings of combinability set forth by the Examiner, initially at pages 8 through 11 of the Answer. We have reconsidered our reasoning as to the affirmance of the fourth and fifth stated rejections, the reasoning set forth in our prior Decision at pages 7 through 9 as to these rejections and make no change in them. Likewise, in considering the

² It is noted that the above noted panel has only recently received this Request for Rehearing.

Appellant's Request for Rehearing, we have reconsidered the arguments as to these corresponding rejections set forth at pages 16 through 20 of the principal Brief on appeal together with the arguments in the Request for Rehearing.

We note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Once again, Appellant's arguments in the Request for Rehearing appear to focus upon the approach of combining structures rather than combining the teachings and suggestions among the prior art relied upon as the Examiner has done in the Answer and Supplemental Answer. Taken from this perspective, we stated earlier and continue to believe that the artisan would have seen a complementary nature to the broad teaching and suggestibility of the references to Gartner and Fitting. Within 35 U.S.C. § 103, the artisan would not have "seen" only the specific structures/database structures set forth, for example, in the paragraph bridging pages 2 and 3 of the Request for Rehearing.

In our prior Decision, we essentially agreed with one of the Appellant's urgings that Gartner did not teach or suggest a plurality of different test systems even though he plainly taught a system for a plurality of users. Additionally, we did not question the Examiner's statement at page

9 of the Answer that Gartner did not specifically disclose combining first and second parameters to form a filename. It was recognized by the Examiner and even recognized by Appellant in the Brief and Request for Rehearing that at the bottom of column 5, Gartner did teach a first value relating to a filename and a second value relating to the name of the server/database system. Figure 2 essentially shows this and column 5, lines 41-54 indicates that an external file reference is based upon the name of a server and the name of a file. Although this comes close to the broadly defined “based on” relationship at the end of independent claim 1 on appeal as well as the combining and in concatenating features of the other independent claims on appeal, we agree with the Examiner’s conclusion that Fitting had more compelling teachings of this exact feature.

To the extent the artisan would not consider Gartner’s teachings as being applicable implacable to plural test systems, the teaching value of Fitting clearly would have caused the artisan to consider that the plural users of Gartner obviously would have analogously encompassed the plural systems of Fitting. It is remarkable how Appellant’s arguments in the Brief and the Request for Rehearing appear to limit the teaching value of Fitting such as to not even encompassed anything corresponding to what the Examiner has said in the paragraph bridging pages 9 and 10 of the Answer, with which we fully agreed in our previous Decision. As the Examiner indicated at the bottom of page 10 of the Answer “Fitting does execute a plurality of steps to combine the two parameters into a filename.”

Appellant asserted at the bottom of page 3 of the Request for Rehearing with respect to independent claims 6, 14, 23, and 27 that we overlooked Appellant’s arguments with respect to these claims and did not

Appeal No. 2006-1778
Application No. 09/776,364

address them. Besides making reference to the Final Rejection in this portion of the Request for Rehearing instead of the Answer, Appellant's arguments here take essentially the same approach as set forth at pages 19 and 20 of the principal Brief on appeal as to the same claims. We said at the top of page 9 of our prior Decision that the arguments as to the fourth and fifth stated rejections principally were directed to Gartner and the alleged deficiencies of this reference (some of which we agreed with in our prior Decision). Appellant's arguments as to Fitting in the Request for Rehearing appear to us to fail to consider the Examiner's reasoning of combinability in the Answer and our embellishments on them at pages 7 and 8 of the prior Decision. Rather than misapprehending and overlooking points raised by Appellant's arguments in the Brief, we have simply not agreed with them.

In view of the foregoing, we have considered Appellant's positions set forth in the Request for Rehearing but do did not consider them to be persuasive to change the views and decision expressed in our prior Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

tdl

Dan C. Hu
Trop, Pruner & Hu, P.C.
Suite 100
8554 Katy Freeway
Houston, TX 77024